

No. 231.

UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT.

OCTOBER TERM, 1894.

JOHN HAMMOND,
Plaintiff in Error,
VS.

STOCKTON COMBINED HARVESTER AND
AGRICULTURAL WORKS,
Defendant in Error.

BRIEF OF PLAINTIFF IN ERROR.

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STATEMENT OF FACTS.

This is an action at law, brought by the plaintiff in error against the defendant in error in the Circuit Court of the United States for the Northern District of California, to recover damages for the infringement of a "design patent," numbered 21,042, and issued to plaintiff in error on September 15, 1891, as appears between pages 28-33 of the Record. It covers a design for a railway car-body, such as is now in use on the California Street Cable Road in the City and County of San Francisco and known as a "double-ender." The action was originally tried before a jury, and resulted in a verdict in favor of the plaintiff in error for \$250, upon which verdict a judgment for that sum, together with costs, was entered. (Record, 12-16.)

Thereafter the defendant in error moved for a new trial, which motion was granted by the court. (See Record, pages 18-19.)

Upon the second trial a jury was waived by the parties and the case was tried before the court sitting without a jury. Upon that trial the court made certain written findings of fact, and upon the same caused a judgment to be entered in favor of the defendant in error, which judgment appears at pages 25 and 26 of the Record.

By those findings the court found all the contested issues of fact in favor of the plaintiff in error, save and except the issue of *patentable invention*. That issue was found by the 9th finding, at pages 23-24 of the Record, and is as follows:

“ That prior to the date of plaintiff’s alleged invention, there was known and in use on the Market Street Cable Road in the City and County of San Francisco and State of California, a combination car consisting of a rectangular enclosed compartment or section, and at one end thereof a skeleton or open-work rectangular section within which were delineated seats lying lengthwise and crosswise of the car, while at the opposite end was an ordinary car platform for ingress and egress of passengers, the whole being surmounted by a horizontal roof surface, while at each end of the car floor was a vertical dasher and beneath the flooring were seen the trucks; the whole of said car being suitably ornamented and embellished; the appearance of which is shown by Letters Patent No. 304,863, granted to H. Root on September 9, 1884, a copy of which was offered in evidence by the plaintiff and marked Plaintiff’s “ Exhibit ii.” and is hereby referred to for further description.

“ That in producing his car-body described and claimed in letters patent sued on, all that the plaintiff did was to

take the said Market street combination car, cut a passage way through the said seats of the open compartment adjoining the closed compartment so as to afford an entrance from the street through the said open compartment to the enclosed compartment; then to remove the rear platform attached to the open compartment and substitute in its place an open compartment with seats and passage ways in all respects like the first mentioned open compartment, and that in making said substitution, trucks were placed underneath said substituted open compartment in all respects like the trucks which had previously been used under said prior open compartment."

As a conclusion of law from the foregoing facts, the court found:

"That the said letters patent for a design for car-bodies referred to herein, are void for want of invention, and that the said defendant is entitled to judgment for costs of suit; and it is ordered that judgment be entered accordingly."

From the foregoing it will be seen that the sole and only ground of the lower court's decision was that the letters patent were void *for want of invention*, that is to say, in producing the patented design, the patentee had not exercised the faculty of invention, in view of the state of the art existing at the time, which said state of the art was represented by the Market street combination cars and the ordinary horse cars.

Thereupon a judgment was entered in favor of the defendant. Plaintiff then prepared a bill of exceptions, which is found from pages 27 to 54 of the Record, and duly sued out a writ of error accompanied by an assign-

ment of errors, and the case is now before this court for review.

The single error to be considered is the finding and conclusion of the lower court that the plaintiff did not exercise the faculty of invention in producing his patented car-body. All other issues of fact were found in favor of the plaintiff in error. The sole question before this court is, does the patented design display a sufficient modicum of invention to sustain the patent within the meaning of the law authorizing the granting of design patents? If it does, then it follows conclusively that the patent is valid and the judgment of the lower court must be reversed.

POINTS AND AUTHORITIES.

I.

Nature of Design Patents.

This is the first case involving a "design patent" which has been brought to the attention of this court, and at the very outset we must remind the court that patents for designs are widely different from patents for mechanical inventions. Patents for mechanical inventions are regulated by section 4886 of the revised statutes, which section provides when and under what circumstances a patent may be granted for a mechanical device. We use the word "device" in its generic sense as including, in the words of the statute, "an art, machine, manufacture or composition of matter." Such patents are the ones which have heretofore been brought before this court. A patent for design, as we have already stated, has never been heretofore brought before this court.

Patents for designs are regulated by a separate and distinct section, to wit, section 4929 of the revised statutes, and the four sections immediately following. By that section, it is provided that—

“ Any person who by his own industry, genius, efforts and expense, has invented and produced any new and useful design for a manufacture, bust, statue, alto-relievo, bas-relief; any new and original design for the printing of woolen, silk, cotton or other fabrics; any new and original impression, pattern, print or picture to be printed, painted, cast or otherwise placed in or worked into any article of manufacture; or any new, useful and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may by payment of the fee prescribed and other due proceedings had, the same as in cases of inventions or discoveries, obtain a patent therefor.”

This statute provides for four general classes of designs, viz.:

1. Any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief.
2. Any new and original design for the printing of textile fabrics.
3. Any new and original impression, ornament, etc., printed on or affixed to any article of manufacture.
4. Any new, useful, and original shape or configuration of an article of manufacture.

The patent in suit falls in the 4th class. It is a “ new, useful and original shape or configuration of an article of

manufacture," to wit: a car-body. A drawing of the same will be found at page 29 of the Record, and the specification immediately follows.

The fundamental characteristic of design patents is that they have reference to the *appearance of a thing*, rather than to its function. They relate to the fine arts, rather than to the utilitarian. As Judge Nixon said in *Theberaith vs. Rubber, etc., Co.* (15 Fed. Rep., 241):

"They differ from patents for inventions or discoveries in this respect, that they have reference to *appearance* rather than utility. Their object is to encourage the arts of decoration more than the invention of useful products. A picture or design that merely pleases the eye is a proper subject for such a patent without regard to the question of utility, which is always an essential ingredient of an invention or discovery patent."

In *Untermeyer vs. Freund* (37 Fed. Rep., 344), Judge Coxe, in speaking of a patentable design, says:

"It must be beautiful. It must appeal to the eye."

And so likewise Mr. Justice Strong, speaking for the Supreme Court, in *Gorham vs. White* (14 Wall., 511), said:

"The acts of Congress, which authorize the grant of patents for designs, were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as *appearance*, and that not an abstract impression or picture, but an aspect given to those objects mentioned in the acts. * * * And the thing invented or produced, for which a patent is given is that which gives a *peculiar or distinctive appearance* to the manufacture or article to which it may be applied or to which it gives form."

Mr. Robinson, in his work on patents, says (Vol. 1, p. 293): "The essence of a design resides in the idea of that configuration or ornamentation which constitutes the new appearance given."

In truth, designs partake more of the nature of a trademark or copyright in many particulars than of a mechanical invention, and in many European countries they are treated as such. (See Fenton on Design Patents, p. 7.)

We do not mean to say that in the United States the law has gone to that extent, but we can certainly say with Judge Coxe: "The policy which protects a design is akin to that which protects the works of an artist, a sculptor, or a photographer, by copyright." (*Untermeyer vs. Freund*, 37 Fed. Rep., 344.)

II.

Differences Between Designs and Inventions.

From the foregoing authorities it is manifest that there is a radical difference between designs and mechanical inventions.

In the domain of mechanical invention, *appearance, form, configuration and shape* amount to nothing (save in a few rare cases where form is of the essence of the invention). Function is the badge of such inventions, and the great problem there is to trace the invention through different forms of mechanical construction. Hence the statements so often met with in patent cases that formal changes are nothing; mere mechanical changes are nothing.

But when we come to design patents we find an exactly opposite rule of law. There function and utility are

of no importance. *Appearance, form, shape and configuration* are everything.

The statute authorizing design patents is separate and distinct from that authorizing mechanical patents. It is differently worded. It relates to a different subject matter. It provides shorter terms of life for the patents, requires smaller fees for their issuance, and provides different remedies for infringement.

It will not be necessary to consider all of these differences, but the main and fundamental one is *the difference in amount of invention required in each case.*

In producing a design we may admit that some exercise of inventive faculty is required; but only a very small amount, and of a very low order, and of a kind different from that required in producing mechanical inventions.

Said Judge Coxe, in *Untermeyer vs. Freund* (37 Fed. Rep., 344):

“ A design requires invention, but a different set of
 “ faculties are brought into action from those required to
 “ produce a new process or a new machine. In each
 “ case there must be novelty, but the design need
 “ not be useful in the popular sense. It must be
 “ beautiful. It must appeal to the eye. The dis-
 “ tinction is a metaphysical one, and difficult to put
 “ into words. A flying wheel, a wheel revolving
 “ rapidly between two outstretched wings, present a
 “ pleasing object to the eye; a graceful pattern for the
 “ handle of a spoon or fork may attract many pur-
 “ chasers, and yet it cannot be said that the embodiment
 “ of these designs requires any exercise of the ‘intuitive

“ faculty of the mind ’ in the sense that this faculty is
“ exercised in inventions like the telephone or the safety
“ lamp. The policy which protects a design is akin to
“ that which protects the work of an artist, a sculptor or
“ a photographer by copyright. It requires but little in-
“ vention, in the sense above referred to, to paint a
“ pleasing picture, and yet the picture is protected, be-
“ cause it exhibits the personal characteristics of the
“ artist, and because it is his. So with designs. If it
“ presents a different impression upon the eye from any-
“ thing which precedes it; if it proves to be pleasing,
“ attractive and popular; if it creates a demand for the
“ goods of its originator, even though it be simple and
“ does not show a wide departure from other designs, its
“ use will be protected. In the active competition of
“ trade a dealer is fairly entitled to the advantage, slight
“ though it be, which attends such enterprise, and a rival
“ in business should not be permitted thus openly and
“ defiantly to invade the territory of another. It is easy
“ for every dealer, with the wide universe before him, to
“ select a design of his own; the appropriation by him of
“ the design of his neighbor is usually so unnecessary
“ and unwarrantable that the law is seldom relaxed for
“ his advantage. It is impossible to read the literature
“ upon this subject without being convinced that the
“ courts, though applying the same rules, have looked with
“ greater leniency upon design patents than patents for
“ other inventions. From the nature of the case it must
“ be so. A design patent necessarily must relate to sub-
“ ject matter comparatively trivial. The object of the
“ law is to encourage those who have industry and genius

“sufficient to originate objects which give pleasure through the sense of sight.”

In *Smith vs. Stewart* (55 Fed. Rep. 482, affirmed in 58 *Id.*, 580), Judge Butler said:

“If the question what constitutes novelty and invention, in the sense of the statute here involved, was now raised for the first time, I might possibly agree with the defendants. It has, however, been raised many times heretofore; and while the decisions are substantially harmonious, the expressions of commissioners and judges regarding it are not. I have examined the cases, but do not propose to discuss them.

“The application of expressions found in a few of them would, I think, overturn a majority of design patents granted, and many of those which have been sustained by the courts. It would seem absurd to say that the designs covered by these patents, generally, exhibit the exercise of ‘inventive genius,’ as the term is commonly applied to mechanical inventions. Turning, for example, to the spoon and fork handle design in the hotly contested case of *Gorham Co. vs. White*, 14 Wall 511, nothing more is found than the skillful use of common scroll work, exhibiting little, if anything, more than good taste; and yet the question of novelty and invention was not even raised; the same may be said of designs involved in a majority of reported cases.

“Some of the rules applied to mechanical patents are wholly inapplicable to those for designs. As said by the Supreme Court in *Gorham Co. vs. White*: ‘To speak of the invention as a combination * * * or to treat it as such is to overlook its peculiarities.’ Such

“ designs generally, if not uniformly, contain nothing
 “ new except the appearance presented to the eye, by
 “ arrangement of previously existing material; such as
 “ lines, scrolls, flowers, leaves, birds and the like. The
 “ combination where several separate objects are em-
 “ ployed, need not be, and cannot be, such as these terms
 “ signify when applied to machinery, ‘the parts coacting
 “ to produce a new and useful result,’ in the sense there
 “ contemplated. The object sought is a new effect upon
 “ the eye alone—a new appearance; and the several parts
 “ need not have any other connection than is necessary
 “ to accomplish this result.”

And as further illustrative of the point under discussion we refer to the following cases:

Gorham vs. White (14 Wall., 511).

Simpson vs. Davis (12 Fed. R., 144).

Foster vs. Crossin (23 *Id.*, 400).

Ripley vs. Elson Glass Co. (49 *Id.*, 929)

N. Y. B. and P. Co. vs. N. J. Car Co. (48 *Id.*,
556).

Same vs. Same (53 *Id.*, 811).

From the foregoing it will be seen that only a minimum of inventive faculty, and that too of the lowest order, is required in producing a patentable design, and in that respect designs differ most materially from mechanical inventions, which require a much higher order of inventive faculty. From this we deduce the conclusion that in determining the presence of patentable invention in a design we cannot apply the rules which obtain in the case of mechanical inventions; at least not

in their rigor. They must be modified to conform to the different nature of the subject-matter.

And this brings us to the point in this case, viz.:

III.

THE LOWER COURT ERRED IN TESTING THE QUESTION OF INVENTION HERE INVOLVED BY RIGIDLY APPLYING THE RULES WHICH OBTAIN IN THE CASE OF MECHANICAL PATENTS.

The sole ground of the learned Judge's decision was an asserted want of invention in the design, and that result was reached by applying in all their rigor the rules of law which relate to mechanical patents.

One of those rules, broadly stated, is that mere duplication is not an exercise of the inventive faculty, and therefore is not patentable. Applying this rule to the case in hand the lower court found as a fact that the Hammond car-body was a mere duplication of the old Market street combination car, and hence not patentable. It was argued that all Hammond did was to put a second dummy on the rear of a Market street car, and thereby produce a double dummy car.

In reaching this result such cases as *Dunbar vs. Meyers* (97 U. S.) and *Slawson vs. R. R. Co.* (107 U. S., 652) were relied on. Those were cases of mere duplication of mechanical devices, pure and simple, without producing any new result. In the first the patentee merely placed two deflecting plates in combination with a circular saw, when the use of one such plate was old. In the second the patentee merely added an additional window pane in a street car fare-box, to obtain additional insight

into the interior. In neither case was any new result obtained, and hence no invention was displayed.

But duplication, even in the case of mechanical patents, sometimes displays invention. The true rule is this: Mere duplication is not patentable, and by that is meant the adding of a second known device which simply doubles the known effect of the first and introduces no new effect; but where the duplication produces a new effect different in kind, then it is patentable.

Thus in *Parker vs. Hulme* (1 Fish, 44), Kane, J., said:

“In regard to the arrangement of vertical wheels *in pairs* on a horizontal shaft, the mere fact that this was a duplication of the single wheel, does not of itself invalidate the patent. Duplication producing a new and useful result, as it was here produced, may be patentable. It is often the material part of the discovery, because it may be that which renders useful what was previously useless. In the case of the paper machine before this Court it was held that a number of rollers acting in pairs for a particular purpose might be patented, though a single pair could not have been.”

And to the same effect are *Wilbur vs. Beecher* (2 Blatch, 132), and *Barnes vs. Straus* (9 Blatch, 553).

Such being the law, we submit that the lower Court erred:

1st. Because the law of duplication was misapplied, even when tested by the rules which apply to mechanical inventions.

2d. Because the law of duplication when applied to designs must receive a more liberal construction than when applied to mechanisms, and under such liberal construction the design in question was clearly patentable.

As to the first proposition, all we have to show is that the Hammond design produces a new and useful result never produced before.

That it does do this admits not of a doubt. Its object is to enable a cable car to run in both directions without turning around, thereby avoiding the use of turn-tables. Only a single grip is used, but it is operated from either dummy. When going in one direction the gripman stands on the front dummy and operates his grip. When the car reaches its destination, instead of being turned around on a turn-table, it is run off on a Y or switch and then started back on the return trip with the gripman standing on what was formerly the rear, but is now the front dummy, and he there operates the same grip. In this way turn-tables are avoided and a saving of great expense is effected. See testimony of Hammond from pages 38 to 43 of Record.

This is a new and highly useful result. It is not a mere duplication, or double effect, or increase of an old result. Hence it involved invention.

Furthermore the quick and extensive adoption of the device all over the country and the great-satisfaction it gave is the most persuasive evidence of invention. (See Test. of Hammond, p. 3-4.)

McGowan vs. Belting Co. (141 U. S. 343).

Barbed Wire Cases (143 *Id.* 284).

Smith vs. Goodyear (93 *Id.* 486).

Gandy vs. Belding Co. (143 *Id.* 595).

Krementz vs. Cottle (148 *Id.* 556).

Topliff vs. Topliff (145 *Id.* 156).

We thus see that even according to the rules as applied to mechanical inventions, the inventive faculty was exercised in producing the patented design. How much stronger, therefore, is our position when tested by the modified rules applicable to designs?

As to the second proposition. The lower court tested the patent by applying in all their strictness the rules applicable to mechanical inventions. We insist that this was error. We were entitled to a more liberal rule of construction. Only a minimum of invention is necessary to sustain a design patent. In a strict sense a design patent is not an invention. It relates to appearance, form, shape, size, configuration, etc., of an article which make it attractive and beautiful. It is of the nature of a trade-mark.

If it produces a new appearance to the eye, either by reason of surface ornamentation or form, configuration or shape, and that new appearance makes the article attractive, then there is a sufficient modicum of what we term *invention*, but which in reality is mere good taste and judgment, to sustain the patentability of the design.

Says the Supreme Court in *Gorham vs. White* (14 Wall, 511):

“The thing invented or produced, for which a patent is given, is that which gives a peculiar and distinctive appearance to the manufacture or article to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes

to secure, for a limited time, to the ingenious producer of those appearances, the advantages flowing from them."

In view of this language, how is it possible to hold that Hammond's design patent is void for want of invention? He has certainly given a *new and original appearance* to a manufactured article, which enhances its value, and increases the demand for it, and it is a meritorious service to the public. It is a new and useful result produced.

That result is produced by adding a second dummy to an old car, accompanied with certain details of construction. The Court calls that duplication, and says to us, duplication is not patentable, and hence your patent is void. But the Supreme Court said, in *Gorham vs. White, supra*: "Manifestly, the mode in which those appearances are produced, has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts the attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. The appearance may be the result of configuration, or of ornament alone, or both conjointly; but, in whatever way produced, it is the new thing or product which the patent law regards. To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities."

We say, therefore, with the Supreme Court, that it is utterly immaterial that the design was produced by *duplication*. The manner or method of its production is of no

new and useful *appearance* or *form* is produced. That such a result has been produced admits not of a doubt. The double-ender cable car is radically and essentially different in appearance from the single-ender. It produces a different appearance to the eye of an ordinary observer, and that different appearance enhances its value, renders it more pleasing to the public, and at the same time increases its utility. We submit that every requirement of the statute has been fulfilled, and that this patent will stand all the tests to which it may be lawfully subjected.

In conclusion we desire to add that the invention is not a trivial one. It is one of great merit, for it not only increases the beauty of the car, but serves a purpose of great utility in saving to the cable roads from \$25,000 to \$30,000 per annum. (Record, p. 41).

Furthermore, the invention immediately went into general and extensive use as soon as Mr. Hammond made it known. It is applicable to electric cars as well as to cable, and there is not an electric road in the State of California that does not use it in some form or other.

In addition to this, we remind the court that the defendant is a willful infringer. The evidence shows that the defendant knew that plaintiff was the inventor of the design and that they had heard that a patent had been applied for by him, but yet they sent their draughtsman to San Francisco, who deliberately made a sketch of the cars built by plaintiff and then proceeded to build cars therefrom. (Testimony of Elliott, pp. 37-8.)

Such conduct certainly cannot recommend the defendant to the leniency of the Court.

We submit that the judgment is erroneous and ought to be reversed.

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Attorney for Plaintiff in Error.

